Group III. – Claims 1, 2 and 5 (each in part) drawn to a method of administering neurotensin-2 agonist to a patient who is, or is at risk of becoming obese, classification dependent on agent structure;

Group IV. – Claims 1, 2 and 6 (each in part) drawn to a method of administering neurotensin-2 antagonist to a patient who is, or is at risk of becoming obese, classification dependent on agent structure;

Group V. – Claims 1, 4 and 5 (each in part) drawn to a method of administering neurotensin-3 agonist to a patient who is, or is at risk of becoming obese, classification dependent on agent structure;

Group VI. – Claims 1, 4 and 6 (each in part) drawn to a method of administering neurotensin-3 antagonist to a patient who is, or is at risk of becoming obese, classification dependent on agent structure;

Group VII. – Claims 9, 10, 11, 12, 13 and 14 (each in part) drawn to a pharmaceutical composition or kit comprising neurotensin-1 agonist and a second compound, classification dependent on agent structure;

Group VIII. – Claims 9, 11, 12 and 14 (each in part) drawn to a pharmaceutical composition or kit comprising a neurotensin receptor ligand other than a neurotensin-1 agonist and a second compound, classification dependent on agent structure;

Group IX. – Claims 15 and 16 (each in part) drawn to methods of treating various disease comprising administering neurotensin-1 receptor ligand, classification dependent on agent structure; and

Group X. – Claim 15 (in part) drawn to methods of treating various disease comprising administering neurotensin receptor ligand other than neurotensin-1, classification dependent on agent structure.

In reply, Applicant elects with traverse Group I. – Claims 1 (in part), 2 (in part), 5 (in part), 7 and 8 drawn to a method of administering neurotensin-1 agonist to a patient who is, or is at risk of becoming obese, classification dependent on agent structure. (For the Examiner's information, in Groups III. and IV., which refer to the neurotensin-2 agonist or antagonist, Applicant's representative believes that the Examiner meant to refer to Claim 3 (which is directed to a neurotensin-2 receptor ligand), instead of referring to Claim 2 (which is directed to a neurotensin-1 receptor ligand).)

Applicant would also request that the Examiner consider joining Groups VII. with Group I. for examination purposes. Group VII. is drawn to a pharmaceutical composition or kit comprising neurotensin-1 agonist and a second compound. In response to the election of species requirement in the present Office Action (which is discussed further in the separate section below), Applicant has narrowed Group VII as follows:

In Group VII., Applicant elects with traverse the following species: In Claim 9, which is a pharmaceutical composition, Applicant elects with traverse a second compound useful for the treatment of obesity. In Claim 11, Applicant would point out that all of these compounds are anti-obesity agents and should be examined together, however, for an election of a single species, Applicant elects with traverse a second compound which is a cannabinoid receptor antagonist. In Claim 12, which is a kit, Applicant elects with traverse a second pharmaceutical composition comprising a compound that is useful for the treatment of obesity. In Claim 14, Applicant would point out that all of these compounds are anti-obesity agents and should be examined together; however, for an election of a single species, Applicant elects with traverse the second pharmaceutical composition comprising a compound which is a cannabinoid receptor antagonist. As noted, these elections are discussed further in the section below.

Applicant would assert that a search for Group I. and Group VII. (particularly as narrowed by the election of species above) in the present application would not place a serious burden on the Examiner. See MPEP § 803. Applicant believes that, as the Examiner is searching for a method of administering neurotensin-1 agonist for treating obese patients or patients at risk of becoming obese (Group I.), he would also be searching for pharmaceutical compositions and kits containing this agonist, whether alone or in combination with other anti-obesity compounds (Group VII.), for the treatment of such patients; and he would not have to conduct a separate search for them. However, if the restriction is maintained, Applicant will be required to file separate patent applications to these compositions and kits, expending additional time and money in doing so.

In fact, the Examiner has admitted that Invention VII and I are related as product and process of use. However, in support of this restriction requirement, the Examiner noted that in the instant case the compounds of Invention VII can be used

in materially different methods other than methods of Invention I, such as in diagnostic methods (e.g., in screening) or biochemical methods (e.g., isolating receptors).

However, in reply, Applicant would point out that Invention VII (Group VII) (as narrowed by the election of species above) is directed to a pharmaceutical composition or kit for the treatment of obesity. This is the same patient population as is being treated by the method of Invention I (Group I). Therefore, Applicant believes that it is reasonable that these inventions be searched together and that they would not place a serious search burden on the Examiner.

In conclusion, in response to the present restriction requirement, Applicant has elected with traverse Group I., as set forth in the present Office Action, and respectfully requests that the Examiner consider joining Group VII. (as narrowed by the present election of species requirement) with Group I. for examination purposes.

ELECTION OF SPECIES

Applicant has been required under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner has stated that, currently, Claims 9, 11, 12 and 14 are generic. Also, the Examiner has stated that if applicant selects Inventions VII. or VIII., one species from the disease targeted by a second compound group must be chosen to be fully responsive. In addition, the Examiner stated that Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

As noted above, Applicant has elected with traverse "obesity" from the species in Claim 9. Claims 10 and 11 would be readable thereon.

As noted above, Applicant has pointed out that all of the compounds in Claim 11 are anti-obesity agents and should be examined together, however, if required to elect a single species, Applicant has elected with traverse "cannabinoid receptor antagonist" from the species in Claim 11. No other claims are dependent on Claim 11.

As noted above, Applicant has elected with traverse "obesity" from the species in Claim 12. Claims 13 and 14 would be readable thereon.

As noted above, Applicant has pointed out that all of the compounds in Claim 14 are anti-obesity agents and should be examined together, however, if required to elect a single species, Applicant has elected with traverse "cannabinoid receptor antagonist" from the species in Claim 14. No other claims are dependent on Claim 14.

Finally, the Examiner has stated that if applicant selects any one of Inventions IX or X, one species from the disease targeted by a second compound group must be chosen to be fully responsive. The Examiner noted that, currently, Claim 15 is generic. In reply, Applicant has not selected Invention IX or X, which includes Claims 15 and 16, and therefore, does not need to elect a species from generic Claim 15.

Reconsideration of this application, as amended, and its early allowance are respectfully requested.

Respectfully submitted,

Date: 12/30/02

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Attachment:
Petition for Extension of Time (2 Copies)
Claims: Version with Markings to Show Changes Made

ATTACHMENT

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 11 has been amended as follows:

11. (Amended) The [method] pharmaceutical composition of claim 9 wherein the second compound is a β_3-adrenergic receptor agonist, a cholecystokinin-A agonist, a monoamine reuptake inhibitor, a sympathomimetic agent, a serotoninergic agent, a dopamine agonist, a melanocyte-stimulating hormone receptor agonist or mimetic, a melanocyte-stimulating hormone receptor analog, a cannabinoid receptor antagonist, a melanin concentrating hormone antagonist, leptin, a leptin analog, a leptin receptor agonist, a galanin antagonist, a bombesin agonist, a neuropeptide-Y antagonist, a thyromimetic agent, dehydroepiandrosterone or an analog thereof, a glucocorticoid receptor agonist or antagonist, an orexin receptor antagonist, a urocortin binding protein antagonist, a glucagon-like peptide-1 receptor agonist, or a ciliary neurotrophic factor.